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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,723	02/27/2001	Helen Biddiscombe	6001-011	3720

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EXAMINER
DYE, RENA

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 03/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/763,723	Applicant(s) BIDDISCOMBE, HELEN	
	Examiner Rena L. Dye	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 8 and 10, the term "hydrogenated hydrocarbon resin" is used. It is not exactly clear what is being referred to by this phrase since Applicant does not define the phrase or give a specific example in the specification. Clarification is requested. What types of resins are included within the definition of hydrogenated hydrocarbon resin within the scope of Applicant's invention?

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the term "and/or" is vague and confusing claim language. Clarification is requested.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, the phrase "blow molded article substantially as herein described with reference to Example 1" is indefinite because the phrase does not positively identify and recite Applicant's invention. Clarification is requested.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Takagi (5,078,817).

Takagi teaches a making of a printed container by winding around the side of a container main body, a label consisting of a transparent heat-shrinkable resin film having a cylindrical shape (column 1, line 60 to column 2, line 3). The container main body can be made of polyethylene (column 2, lines 65-68). As the cylindrical heat-shrinkable transparent film having a print at the inner side, used in the process of the present invention, there can be used a film made of the same resin as constituting the side of the container main body, for example polypropylene...or the like. When the container needs to have a heat-insulating property, there is used a cylindrical label obtained by laminating a foamed shrinkable polypropylene to a film (e.g. a polypropylene film) having a print at the inner side. The films can be biaxially stretched to impart a heat-shrinking property (column 3, lines 25-40). The shrinkage factor of the shrinkable film used is 5-55%, preferably 10-50% at a treating temperature of about 90-120 °C.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rackovan et al. (5,435,963).

Rackovan et al. teaches an in-mold label for labelling high density polyethylene containers (column 12, lines 48-53; figure 1). Examples 1-3 and 7 disclose a labelling film having a base layer comprising a propylene homopolymer. The film may be stretched in the machine and cross (transverse) directions to be biaxially oriented (column 3, lines 59-64). It is noted that the compositions in the two outer layers are similar. The result is that the construction is well balanced with respect to heat-shrinkability at both sides of the construction.

Although Rackovan et al. fails to expressly teach "a shrinkage of at least 4% in both the machine and transverse directions...", it would have been obvious to one having ordinary skill in the art to have varied the degrees of shrinkage within the thickness of the label to have balanced the shrinkability and to have minimized curling.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Takagi (5,078,817).

Takagi teaches a making of a printed container by winding around the side of a container main body, a label consisting of a transparent heat-shrinkable resin film having a cylindrical shape (column 1, line 60 to column 2, line 3). The container main body can be made of polyethylene (column 2, lines 65-68). As the cylindrical heat-shrinkable transparent film having a print at the inner side, used in the process of the present invention, there can be used a film made of the same resin as constituting the side of the container main body, for example polypropylene...or the like. When the container needs to have a heat-insulating property, there is used a cylindrical label obtained by laminating a foamed shrinkable polypropylene to a film (e.g. a polypropylene film) having a print at the inner side. The films can be biaxially stretched to impart a heat-shrinking property (column 3, lines 25-40). The shrinkage factor of the shrinkable film used is 5-55%, preferably 10-50% at a treating temperature of about 90-120 C.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,306,490. Although the

conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to have adhered the label as recited in the '817 patent to a container, in particular a high density polyethylene blow-molded article.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rena L. Dye whose telephone number is 703-308-4331. The examiner can normally be reached on Monday -Thursday 8:30 AM - 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Rena L. Dye
Primary Examiner
Art Unit 1772

R. Dye
March 11, 2002